

REMARKS

Allowable Subject Matter:

As an initial matter, Applicant sincerely thanks the Examiner for indicating that claims 1-14, 29-35, 37, 39-41 and 43-44 are allowed.

Claim Objections:

The Examiner has objected to claim 36, which has been canceled. Thus, this objection is now moot.

Claim Rejections:

Claims 1-24, 26-35, 37 and 39-44 are all of the claims pending in the present application and currently claims 15-24, 26-28, and 42 stand rejected.

35 U.S.C. § 102(e) Rejection - Claims 15-16, 18, 20-21, 23-24 and 26-28:

Claims 15-16, 18, 20-21, 23-24 and 26-28 continue to stand rejected under 35 U.S.C. § 102(e) as being anticipated by the '009 Risch reference. In view of the following discussion, Applicant continues to disagree with the Examiner and respectfully traverses the above rejection.

Risch teaches away from the present invention:

As an initial matter, Applicant again notes that Risch does not disclose an optical fiber with all the limitations set forth in the claims and, more importantly, provides one of ordinary skill in the art an opposite teaching than that of the present invention. Specifically, according to Figure 1 of Risch, the cable 10 has a core comprised of a plurality of buffer tubes 12, each of which house optical fibers 14. A protective outer jacket 20 is disposed over the core region on the exterior of the buffer tubes 12, wherein water blocking gels 19 are typically disposed within

the buffer tubes 12 (*see* column 2, line 64-column 3, line 5). Risch teaches that if an i-PP buffer tube is used, the water blocking gels were absorbed by the buffer tube material causing substantial swelling thereof (*see* column 4, lines 29-34). As illustrated in Figure 2, the mineral oil, polybutene, and poly alpha-olefin base oils traditionally used to produce gels can swell polyolefin buffer tube materials by 6% or more. Risch teaches that such an absorption is unacceptable and detrimental to the cable. In addition, Figure 2 illustrates that substantial elimination of the low molecule weight component fraction below 2000 dramatically reduces buffer tube swelling (*see* column 5, lines 29-51). The results shown in Figure 3 illustrate that the gel that is preferable, according to Risch, causes less than 1% swelling in the nucleated, impact modified polypropylenes at temperatures below 60 °C (*see* column 5, lines 59-64).

Thus, on basis of the teachings of Risch, a polyolefin based gel having a reduced buffer tube swelling capacity is preferred. This is in contrast with the technical feature of present claimed invention, as set forth in claim 15, where it is desired that the gel swellable portion swells more than 10% at 85 °C. Risch does not suggest or provide any incentive to use a gel swellable portion which swells more than 10% at 85 °C. In fact, Risch directs the skilled person in the art in another direction, i.e. to use a polyolefin based gel that does not have a low molecule weight fraction, which low molecule weight fraction is characteristic of a mineral oil *which* can swell polyolefin buffer tube materials by 6% or more.

Risch fails to disclose contact between the gel-swellable layer and fiber outer layer:

In addition to the foregoing, Applicant again submits that Risch fails to disclose each and every feature of the claimed invention, as required under the provisions of 35 U.S.C. § 102(e). Namely, Risch fails to disclose having a gel-swellable layer come in contact with an outer layer of the optical fiber.

Claim 15 recites that “a gel -swellable portion contact[s] an outer surface of [the] optical fiber.” *See* claim 15. Applicant notes that there is no disclosure or suggestion, in Risch ‘009, of having the fibers come in contact with the buffer tubes 12. In fact, Applicant submits that it is known that it is desirable to avoid contact between buffer tubes and optical fibers. Therefore, Applicant submits that Risch ‘009 fails to disclose each and every feature of claim 15, either expressly or inherently, as asserted by the Examiner.

Further, in rejecting claim 15 (as set forth in the previous Office Actions) the Examiner asserts that “Risch et al discloses that i-PP buffer tubes swell more than 10% at 85°C in various water blocking gels (Fig. 2).” Applicant submits that this supports Applicant’s position. Namely, Risch ‘009 fails to disclose having the buffer tubes contacting any of the fibers. There is no disclosure of any kind, which is required under 35 U.S.C. § 102(e) of contact between the buffer tube and the fibers.

As discussed previously, this is undesirable as the performance of the fiber can be adversely affected by contacting the buffer tubes. As such, the Examiner can not rely on the buffer tubes of Risch ‘009 as disclosing “a gel-swellable portion contacting an outer surface of [the] optical fiber.” This is simply not disclosed in Risch ‘009. The present invention, in claim

15, uses a gel-swellaable layer on the fibers to provide protection and cushioning. This is not disclosed, taught or suggested in Risch '009.

Further, the Examiner's assertion that the fibers will make contact with the buffer tubes is insufficient to anticipate the present invention. Under the provisions of 35 U.S.C. § 102(e) the reference must disclose "each and every" feature of the claimed invention. The Examiner's assertion is simply not disclosed within Risch, nor is it inherent, as asserted by the Examiner.

"Inherency":

When attempting to establish the invalidity of a claim under 35 U.S.C. § 102, it must be shown that "all of the elements and limitations of the claim are found within a single prior art reference." Scripps Clinic & Research Foundation, Revlon, Inc. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991) (citations omitted). "There must be no difference between the claimed invention and the reference disclosure," the subject matter in the reference "must be identical in all material respects." See Id.; and Hupp v. Siroflex of America Inc., 43 U.S.P.Q.2d 1887, 1890 (Fed. Cir. 1997) (emphasis added). As stated above, this is not the case with regard to the pending claims as Risch fails to disclose the buffer tubes making contact with the fibers. *See supra*. (It is also noted that the Examiner admits that this is the case, *see* Final Office Action, page 5.)

To cure this deficiency, the Examiner indicates that because there is no supporting structure shown, this aspect of the present invention is "inherent" in the Risch disclosure. *See* Office Action, page 5. Applicant does acknowledge that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a

reference “inherently” teaches the missing element or elements of the claimed invention. See In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981). However, evidence of inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. (citing In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure. See Finnigan Corp. v. I.T.C., 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference). This is no different than the present circumstance.

In the present application, assuming the Examiner’s assertions are correct, than only one of two circumstances may possibly or potentially exist in Risch. The first is that the fibers do not touch the buffer tube (as is clearly disclosed in Risch), and the second is that they do touch (which is clearly not disclosed). Thus, according to the Examiner, the circumstances of the

present case are no different than that before the court in Finnigan Corp. As discussed above, in Finnigan Corp. the court clearly stated that even if one of only two possibilities may exist, that is insufficient to make a claim of “inherency.” According to the Examiner, one of two possibilities exist in the present case, i.e. the fibers touch, or they do not touch. In a case such as this the Federal Circuit has clearly indicated that inherency simply does not apply.

Additionally and independently, Applicant notes that Risch is not silent on this issue, thus preventing the presumption of two possibilities (i.e. touching or no touching). Namely, as shown in Figure 1, et seq. none of fibers are shown making contact with the buffer tubes.

In view of the foregoing, Applicant submits that Risch ‘009 fails to disclose each and every feature of the present invention, as set forth in claim 15. Therefore, Risch ‘009 fails to anticipate the claimed invention as required under the provisions of 35 U.S.C. § 102(e). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 102(e) rejection of this claim. Further, as claims 16, 18, 20-21, 23-24 and 26-28 depend on claim 15, Applicant submits that these claims are also allowable, at least by reason of their dependence.

35 U.S.C. § 103(a) Rejection - Claims 17, 19 and 22:

Claims 17, 19 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Risch ‘009. However, as these claims depend on claim 15, Applicant submits that these claims are allowable, at least by reason of their dependence.

Additionally and independently, as noted above Risch is directed, and teaches, a cable having different characteristics than that claimed by the present invention. As set forth in the

discussion above regarding the Risch reference, if one of ordinary skill in the art were to take the teachings of Risch, they would be motivated to reduce the amount a gel absorption as much as possible. The skilled artisan would not be motivated to increase the amount of swelling to more than 10%. This is exactly what Risch teaches to avoid. Thus, contrary to the assertions of the Examiner, the skilled artisan would not take the teachings of Risch to obtain the present invention. A skilled artisan would only be motivated to reduce swelling as much as possible.

35 U.S.C. § 103(a) Rejection - Claim 42:

Claims 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Risch reference. However, Applicant notes that claim 42 depends on claim 15. Applicant submits that Risch does not teach or suggest each and every limitation of claim 15, and as such, fails to teach or suggest each and every feature of claim 42. For example, Risch fails to teach or suggest at least having “a gel -swellable portion contact[s] an outer surface of [the] optical fiber.” See claim 15.

As with the above claims, Risch is directed, and teaches, a cable having different characteristics than that claimed by the present invention. As set forth in the discussion above regarding the Risch reference, if one of ordinary skill in the art were to take the teachings of Risch, they would be motivated to reduce the amount a gel absorption as much as possible. The skilled artisan would not be motivated to increase the amount of swelling to more than 10%. This is exactly what Risch teaches to avoid. Thus, contrary to the assertions of the Examiner, the skilled artisan would not take the teachings of Risch to obtain the present invention. A skilled artisan would only be motivated to reduce swelling as much as possible.

AMENDMENT UNDER 37 C.F.R. §1.116
Application Number 09/851,247

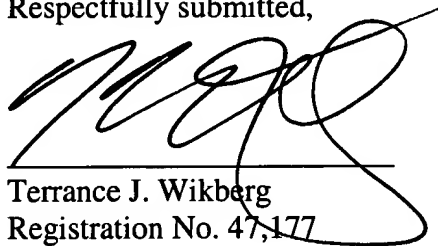
Our Ref: A7966
Art Unit: 2874

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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